



Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler et al

Group Art Unit: 1714

5 Serial No.: 09/810,920

Examiner: Peter Szekely

Filing Date: March 16, 2001

Title: Polymeric Thickeners for Oil-containing Compositions

Mail Stop Amendment, Commissioner for Patents

10 P.O. Box 1450, Alexandria, VA 22313-1450

**REPLY**

**INTRODUCTORY COMMENTS**

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This paper is a reply to the Office Action mailed June 23, 2004. Please extend the term for reply by two months, i.e. to November 23, 2004. Reconsideration, reexamination and allowance of this application are requested in view of the Amendments and Remarks below and the Terminal Disclaimer attached hereto.

20 Authorization to pay the fees for the extension and for the Terminal Disclaimer is attached.

**STATEMENT OF THE SUBSTANCE OF THE INTERVIEWS**

25 (1) A telephone interview took place between Examiner Szekely and the undersigned on October 7, 2004. The Interview Summary prepared by the Examiner is correct, but the following additional comments are needed to record the substance of the interview.

**CERTIFICATE OF MAILING UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop Amendment Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 On November 23, 2004

Typed name of person signing this certificate: T. H. P. Richardson  
Signature

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02 FC:2202 72.00 DA

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03 FC:2252 215.00 DA

At the beginning of the interview, the undersigned asked the Examiner to read, with him, paragraph 6 of Dr. Bitler's declaration, which states, with accompanying rationale, that, in Mueller, "the presence of the additive makes the composition thinner, not thicker", in order that there could be no doubt what was stated in that paragraph. The Examiner replied that it was unnecessary to go through paragraph 6, because he had already considered the declaration and because he knew, from his own knowledge and firsthand experience, that the effect of adding a pour point depressant to an oil was to increase the viscosity of the oil.

The undersigned asked the Examiner whether he could point to disclosure in the Mueller reference itself that there was an increase in the viscosity of the oil when the pour point depressant was added. The Examiner stated in reply that there was no disclosure in the Mueller reference about the effect of the additive on the viscosity of the oil, whether to make the oil thicker or thinner.

The undersigned then again asked the Examiner to read through, with him, paragraph 6 of Dr. Bitler's declaration. The Examiner again refused to do so. The Examiner then referred to the previously cited Morawsky reference and the newly cited McCoy, Norbury, Paboucek and Franck references in support of his position. When the undersigned pointed out that the outstanding Office Action stated explicitly that "Morawsky et al. is not part of the rejection anymore", the Examiner maintained that he was nonetheless entitled to rely upon it. There was no discussion of the McCoy, Norbury, Paboucek and Franck references. However, for the sake of the record, it is noted that these references do not, in Applicant's opinion, support the Examiner's position.

The undersigned then again asked the Examiner to read, with him, paragraph 6 of Dr. Bitler's declaration. The Examiner again refused to do so, stating that it would be a useless exercise.

The discussion then turned to the wording for the "cosmetic composition" claims. Applicant has argued, contrary to the outstanding Office Action, that these claims are limited to compositions suitable for use as cosmetics. The Examiner stated that, in his opinion, only claims naming specific types of cosmetic composition could be regarded  
5 as limited to compositions suitable for use as cosmetics, and that such claims were patentable. He did not agree that the claim scope argued by the Applicant for these claims could be obtained by limiting the claims to cosmetic compositions as defined in the Food, Drug and Cosmetic Act (cited on page 18 of the Reply mailed Jan 27, 2003).

10 (2) A personal interview took place between SPE Jagannathan, Examiner Szekely and the undersigned on November 1, 2004. The Interview Summary prepared by SPE Jagannathan is correct, but the following additional comments are needed to record the substance of the interview.

15 At the beginning of the interview, the undersigned explained paragraph 6 of the Declaration by Dr. Bitler. Examiner Szekely stated he knew, from his own knowledge and firsthand experience, that the effect of adding a pour point depressant to an oil was to increase the viscosity of the oil. SPE Jagannathan stated that since Mueller  
20 disclosed additives within the scope of the claims and the use of those additives in a concentration range overlapping the concentration range used by Applicant, Dr. Bitler's evidence did not overcome the rejection. The undersigned pointed out that the claims require that the additive is present in an amount sufficient to thicken the oil, which is contrary to Mueller's teaching. SPE Jagannathan did not agree that this was important.

25 Examiner Szekely then referred to a new document , French patent No. 2,131,111, which is in the French language, and an abstract thereof in the English language. Examiner Szekely stated that this new document provided support for his position, and indicated that if Applicant argued for the patentability of claims now  
30 rejected under 35 USC 102 and/or 103, this new document would be used as a reference in a further rejection of those claims. The accompanying IDS refers to the new document in question.

SPE Jagannathan and Examiner Szekely agreed that, if the claims were restricted to the claims which were not rejected under 35 USC 102 and/or 103, the application would be allowed (no reference was made to the provisional rejection of all the claims for double patenting).

Amendments to the specification begin on page 5 of this Reply.

Amendments to the claims begin on page 8 of this Reply

Remarks/arguments begin on page 27 of this Reply.